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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,151	01/25/2002	Yihan Liu	DC4978	9548

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Dow Corning Corporation
Intellectual Property Department
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EXAMINER	
JIANG, SHAOJIA A	

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/055,151	LIU ET AL.	
	Examiner	Art Unit	
	Shaojia A Jiang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *9,10 and 12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *9,10 and 12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

In view of the appeal brief filed on January 12, 2004, PROSECUTION IS HEREBY REOPENED. A new ground of rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-10, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitations, " a silicon atom containing monomer" and “a polymerization catalyst”, in these claims render the instant claims indefinite. One of ordinary skill in the art could not ascertain and interpret the **metes and bounds** of the patent protection

desired as to " a silicon atom containing monomer" and "a polymerization catalyst" encompassed thereby.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9-10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halloran (EP 1031344, PTO-892) in view of Kasprzak (US 5,443,760 of record).

Halloran discloses a method of making the instant silicone oil-in-water emulsion composition by emulsion polymerization by adding an emulsion polymerization catalyst such as a strong acid or a strong base ring-opening polymerization catalyst (see page 3 lines 11-35) comprising the particular instant steps for the making herein (see also abstract, page 3 lines 1-5) such as comprising (i) preparing an aqueous phase containing water, non-ionic surfactant, and optionally one or more organic surfactants; (ii) preparing an oil phase comprising a silicon atom containing monomer polymerizable such as a cyclic siloxane monomer (see page 3 lines 40-54) to a silicone oil; (iii) combining the aqueous phase and the oil phase, (iv) adding a polymerization catalyst; (v) heating and agitating the combined phases for a time sufficient to allow the silicon atom containing monomer to polymerize to a silicone by the opening of the ring of a

cyclic siloxane monomer; (vi) recovering a silicone oil-in-water emulsion containing the silicone oil; and (vii) combining the silicone oil-in-water emulsion with a salt component, a solvent component, or a combination thereof (see page 4 line 51-pag 5 line 6; claims 1-4).

Halloran does not expressly disclose the employment of the particular non-ionic surfactant such as a silicone polyether surfactant in the method herein.

Kasprzak discloses a method of making the instant silicone oil-in-water emulsion composition comprising the particular similar steps for the making herein and the particular components employed in the method such as of the particular non-ionic surfactant such as a silicone polyether surfactant (see abstract, col.2-4, and claims 1-8). Kasprzak also discloses the employment of the instant particular components such as the salt, i.e., sodium chloride, aluminum chloride, or ammonium chloride (see col.6 lines 40-45); a lower alkyl alcohol, i.e., ethanol and isopropanol, or a solvent herein such as propyl and octyl esters, fatty alcohols (see col.4 lines 64-68).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the particular non-ionic surfactant such as a silicone polyether surfactant in the method herein.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ the particular non-ionic surfactant such as a silicone polyether surfactant in the method herein since the same method of making the instant silicone oil-in-water emulsion of Halloran comprising the same method steps using non-ionic surfactant broadly is known in the art according to Halloran. The particular non-

ionic surfactant such as a silicone polyether surfactant employed in the similar method of Kasprzak such as of Kasprzak is also known. Thus, a silicone polyether surfactant is a known art-recognized non-ionic surfactant and is also known water soluble. Therefore, one of ordinary skill in the art would have reasonably expected that a known art-recognized non-ionic surfactant, a silicone polyether surfactant, would have the same or substantially similar usefulness as a non-ionic surfactant in the same method of making the instant silicone oil-in-water emulsion of Halloran.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9-10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gee et al. (US 5,891,954 of record).

Gee et al. discloses a method of making the instant silicone oil-in-water emulsion by emulsion polymerization comprising the particular instant steps for the making herein, in particular adding the blend of the silicone polyether and the organopolysiloxane containing emulsion to aqueous phase to form the emulsion and the particular components employed in the method (see abstract, col.2-4, and claims 1-17). Gee et al. also discloses the employment of the instant particular components such as

the salt, i.e., ammonium chloride (see col.6 lines 23-30); a lower alkyl alcohol, i.e., ethanol (see Example XIV at col.10 lines 19-20), or a solvent herein such as fatty alcohols, ethers or aromatic compounds (see col.4 lines 58 to col.6 line 58).

Gee et al. does not expressly disclose the specific order and sequence of the method steps wherein a silicone polyether surfactant is added to the silicone oil-in-water emulsion.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to add a silicone polyether surfactant to the silicone oil-in-water emulsion.

One having ordinary skill in the art at the time the invention was made would have been motivated to add a silicone polyether surfactant to the silicone oil-in-water emulsion since the specific order and sequence of this particular step is not seen critical to the same method of making the instant silicone oil-in-water emulsion of Gee et al. because one of ordinary skill in the art would recognize that a silicone polyether is known to water soluble and thus soluble in the silicone oil-in-water emulsion. Moreover, a silicone polyether is stable and does not participate any reaction during emulsion polymerization of a cyclic siloxane monomer. Hence, adding before or after the emulsion polymerization would not be critical to making silicone oil-in-water emulsion. Thus, the specific order and sequence of this particular step is seen to be not critical and indifferent to the same method of making the instant silicone oil-in-water emulsion of Gee et al.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 9-10 and 12 as amended now are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 5,891,954.

Although the conflicting claims are not identical, they are not patentably distinct from each other for the same reasons as discussed in the 103(a) rejection above.

Claims 9-10 and 12 as amended now are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,071,975.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is drawn to the same method of making silicone oil-in-water emulsion comprising substantially similar steps to the instantly claimed. Hence these methods between in the patent and in the instant application are seen to substantially overlap.

Thus, the instant claims 9-10 and 12 are seen to be obvious over the claims 1-12 of U.S. Patent No. 6,071,975.

Applicant's arguments in the appeal brief filed on January 12, 2004 with respect to the rejections in the previous Office Action December 30, 2003 have been considered but are moot in view of the new ground(s) of rejections above.

Applicant's arguments in the appeal brief filed on January 12, 2004 with respect to the rejections in the previous Office Action December 30, 2003 have been considered but are moot in view of the new ground(s) of rejections above.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is 571.272.0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on 571.272.0629. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

S. Anna Jiang, Ph.D.
Patent Examiner, AU 1617
April 6, 2004

SHAOJIA ANNA JIANG
PATENT EXAMINER